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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,311

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Charles E. Narad

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,311

Applicant(s)

NARAD ET AL.

Examiner

Robert B. Harrell

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2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 Jyly 2005 & 05 December 2005 et seq.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20060126.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached Office Action.

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1. Claims 65-86 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are directed to a compiler defined invention and thus the Title must include some mention to such.
3. The claims are now directed to a compiler. However, the specification is not confined to only the defined invention within the claims. Thus a new Specification (including Drawings and Abstract) is required which modifies the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims as they currently stand within this Application. Per MPEP 1302.01 patents should be confined in their disclosures to the respective inventions patented (see 37 CFR 1.71 and 1.73) and not complicated by extraneous matter. In doing so, the applicant is reminded to include all related United States Patent Application (i.e., Abandoned, Pending, or their corresponding United States Patent Number). The applicant is further reminded of the provisions of 37 C.F.R. 1.125, with respect to mark-up versions and to add a statement, on a separate paper, that the Substitute Specification contains "No New Matter". There shall be no shaded boxes (i.e., see page 110 of the current specification) as such are effectively too darkened to read in electronic form. Review of this matter maybe obtained from <http://portal.uspto.gov/external/portal/pair> to which insert the United States Patent Application number of this application 10748311 and, after clicking "Submit", click "Image File Wrapper" to click "Specification 206" pages and go to page 110 of the specification (page 111 for the PDF) as an example. As is quickly noted, the shaded boxes are not legible, the contents unknown from the scanned version; hence a requirement for a Substitute Specification as supported by this specification.
4. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings (claimed subject matter is not shown in figures making the claims objectable), and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). The drawings must incorporate the invention defined in the claims. Also, shading of diagrams within the specification make such not legible from the scanned version (do not shade). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. **Claims 65-75 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter since such reads on (encompass) printed matter and/or carrier waves as such lack being **embodied on a tangible computer readable storage medium** (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106).

7. The following is a quotation of the first paragraph of 35 U.S.C 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. The specification is objected to under 35 U.S.C 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure for the reasons indicated infra. In other words, there is no enablement for the claimed subject matter. Specifically, the claims recite a compiler. However, the only compiler mentioned in the specification is an NCL compiler. The claims recite an instruction set statement to declare a network protocol. However, none is covered in the specification. The claims recite an instruction set statement to specify a rule. However, none is covered in the specification. The claims recite syntax (i.e., claim 68, claim 71, claim 73, claim 79, claim 82, and claim 84, as examples). However, none is covered in the specification. The invention defined in the claims has not been enabled in the specification unless they are in the shaded boxes.

9. The specification is objected to under 35 U.S.C 112, first paragraph, as failing to adequately describe the defined invention. In other words, there is no written description for the claimed subject matter. Specifically, the claims recite a compiler. However, the only compiler mentioned in the specification is an NCL compiler. The claims recite an instruction set statement to declare a network protocol. However, none is covered in the specification. The claims recite an instruction set statement to specify a rule. However, none is covered in the specification. The claims recite syntax (i.e., claim 68, claim 71, claim 73, claim 79, claim 82, and claim 84, as examples). However, none is covered in the specification. The invention defined in the claims has not been provided in a written description unless they are in the shaded boxes.

10. **Claims 65-86 are twice rejected under 35 U.S.C. 112, first paragraph**, one for enablement and one for written description, for the reasons set forth in the objection to the specification.

11. Such objection and rejection under 35 U.S.C. 112, first paragraph, was presented in examiner's prior Office Action and thus the objection and rejection under 35 U.S.C. 112, first paragraph, are hereby incorporated by reference into this rejection and continue.

12. The applicant's response, filed 26 July 2005, argued the above recited objections and rejections to the specification under 35 U.S.C. 112, first paragraph, by stating in substance:

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The Examiner rejected old claims 2-23 (now 65-86) under 35 U.S.C. 112 as both failing to comply with the written description requirement and with the enablement requirement. In particular, the Examiner identified old claims 5, 8, 10, 16, 19, and 21 (renumbered as 68, 71, 73, 79, 82, and 84). However, the specification provides support for all of the pending claims throughout the text including those claims specifically identified. For example, a stated objective of the application in the "Summary" section is a "compiler for NCL" (NetBoost Classification Language) that "generates code for multiple processors" (page 10, lines 17-18). As described, the system includes a classification engine (CE) which is a "microprogrammed processor" (page 64, line 15). The specification further states that the CE's microassembly language "can be generated automatically from a compiler which translates CE program from a higher-level language such as NetBoost Classification Language (NCL)" (page 83, lines 21-23)). The Classification Language itself is described in great detail in its own section and lists a sample syntax of the instruction set statements in the language, a corresponding description of each statement, and sample usage of the statements to process network packets (pages 105-page 126). In particular, this section describes the recited "protocol" statement (claims 68 and 79) on pages 111-112, the recited "demux" statement (claims 71 and 82) on pages 113-114, and the recited "set search" statement on pages 118-119 (claims 73 and 84). Due to the specification passages identified above providing both written description and enablement of the recited limitations, in addition to other passages interwoven throughout the specification, Applicants respectfully request withdrawal of the rejection of the claims. However, the specification makes it appear NCL (NetBoost) is conventional and not the invention while also being silent as to its construct in the manner so defined in the claims. Furthermore, recited limitations (for example) such as "an instruction set statement to declare a network protocol, the statement having a syntax to name packet data at one or more specified locations within a network packet" is not provided in the specification or those syntax such as in claim 68 for example. While the applicant arguments is well noted, a fundamental problem maybe that the shading of diagrams (e.g., see page 110) makes the print not legible. A new Substitute Specification finding support in the current Specification and limited to the defined invention may resolve and make moot these matters. Review of this matter maybe obtained from <http://portal.uspto.gov/external/portal/pair> to which insert the United States Patent Application number of this application 10748311 and, after clicking "Submit", click "Image File Wrapper" to click "Specification 206" pages and go to page 110 of the specification (page 111 for the PDF). As is quickly noted, the shaded boxes are not legible, the contents unknown from the scanned version; hence a requirement for a Substitute Specification

13. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 65-86 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention for the reasons outlined below.

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15. Per claim 65 and claim 76, "value(s)" fails to clearly define the meets and bounds of the invention because of the parentheses.

16. Phrases such as "the second process" is an example of numerous cases where clear antecedent basis are lacking and not an exhausting recital. Any other term(s) or phrase(s) overlooked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent basis also is indefinite for the reasons outlined in this paragraph. This is an example of numerical antecedent bases for even if there was "a second processor" there is no clear "first processor" unless it be that on line 10 of claim 76. Failure to correct all existing cases where clear antecedent basis are lacking can be viewed as non-responsive. Nonetheless, should a response yield all claims allowable short *a few* cases where clear antecedent basis are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent basis are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of allowance by the applicant.

18. The claims stand allowable over the art of record since the art of record failed to teach or remotely suggest a compiler which caused a processor to access a source code implementing a computer language having an instruction set that contained a statement to declare a network protocol and an instruction set statement to specify a rule to cause another processor to perform in the manner so defined in the claims.

19. *A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).*

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.


21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

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ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142